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APPLICATION NO.	FILING DATE	FIRST NAMED INVENTOR	ATTORNEY DOCKET NO.	CONFIRMATION NO.
09/911,367	07/23/2001	Clark R. Landis	032026-0594	3382

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EXAMINER	
EPPERSON, JON D	
ART UNIT	**PAPER NUMBER**
1639	10

DATE MAILED: 09/10/2003

Please find below and/or attached an Office communication concerning this application or proceeding.

DOCKETED
BY SJD DATE 9/15/03
TICKLER
BY JP DATE 9/16/03
ACTION (DUE DATE) Response to 1-ms 8
(Restriction Requirement (10/10/03)

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Office Action Summary	Application No.	Applicant(s)	
Applicant Copy	09/911,367	LANDIS ET AL.	
	Examiner	Art Unit	
	Jon D Epperson	1639	

-- The MAILING DATE of this communication appears on the cover sheet with the correspondence address --

Period for Reply

A SHORTENED STATUTORY PERIOD FOR REPLY IS SET TO EXPIRE *1* MONTH(S) FROM THE MAILING DATE OF THIS COMMUNICATION.

- Extensions of time may be available under the provisions of 37 CFR 1.136(a). In no event, however, may a reply be timely filed after SIX (6) MONTHS from the mailing date of this communication.
- If the period for reply specified above is less than thirty (30) days, a reply within the statutory minimum of thirty (30) days will be considered timely.
- If NO period for reply is specified above, the maximum statutory period will apply and will expire SIX (6) MONTHS from the mailing date of this communication.
- Failure to reply within the set or extended period for reply will, by statute, cause the application to become ABANDONED (35 U.S.C. § 133).
- Any reply received by the Office later than three months after the mailing date of this communication, even if timely filed, may reduce any earned patent term adjustment. See 37 CFR 1.704(b).

Status

1)☐ Responsive to communication(s) filed on _____ .

2a)☐ This action is **FINAL**. 2b)☒ This action is non-final.

3)☐ Since this application is in condition for allowance except for formal matters, prosecution as to the merits is closed in accordance with the practice under *Ex parte Quayle*, 1935 C.D. 11, 453 O.G. 213.

Disposition of Claims

4)☒ Claim(s) *1-54* is/are pending in the application.

4a) Of the above claim(s) _____ is/are withdrawn from consideration.

5)☐ Claim(s) _____ is/are allowed.

6)☐ Claim(s) _____ is/are rejected.

7)☐ Claim(s) _____ is/are objected to.

8)☒ Claim(s) *1-54* are subject to restriction and/or election requirement.

Application Papers

9)☐ The specification is objected to by the Examiner.

10)☐ The drawing(s) filed on _____ is/are: a)☐ accepted or b)☐ objected to by the Examiner.

Applicant may not request that any objection to the drawing(s) be held in abeyance. See 37 CFR 1.85(a).

11)☐ The proposed drawing correction filed on _____ is: a)☐ approved b)☐ disapproved by the Examiner.

If approved, corrected drawings are required in reply to this Office action.

12)☐ The oath or declaration is objected to by the Examiner.

Priority under 35 U.S.C. §§ 119 and 120

13)☐ Acknowledgment is made of a claim for foreign priority under 35 U.S.C. § 119(a)-(d) or (f).

a)☐ All b)☐ Some * c)☐ None of:

1.☐ Certified copies of the priority documents have been received.

2.☐ Certified copies of the priority documents have been received in Application No. _____ .

3.☐ Copies of the certified copies of the priority documents have been received in this National Stage application from the International Bureau (PCT Rule 17.2(a)).

* See the attached detailed Office action for a list of the certified copies not received.

14)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. § 119(e) (to a provisional application).

a) ☐ The translation of the foreign language provisional application has been received.

15)☐ Acknowledgment is made of a claim for domestic priority under 35 U.S.C. §§ 120 and/or 121.

Attachment(s)

1) ☐ Notice of References Cited (PTO-892)
2) ☐ Notice of Draftsperson's Patent Drawing Review (PTO-948)
3) ☐ Information Disclosure Statement(s) (PTO-1449) Paper No(s) _____ .
4) ☐ Interview Summary (PTO-413) Paper No(s). _____ .
5) ☐ Notice of Informal Patent Application (PTO-152)
6) ☐ Other:

DETAILED ACTION

Please note: The Group and/or Art Unit location of your application in the PTO has changed. To aid in correlating any papers for this application, all further correspondence regarding this application should be directed to **Group Art Unit 1639**.

Election/Restriction

1. Restriction to one of the following inventions is required under 35 U.S.C. 121:

I. Claims 1-17, 19-23, drawn to a method for "synthesizing a diazaphosphacycle", classified variously in class 564, subclass 16; class 423, subclass 407.

II. Claims 24, 29-32, 37-39 and 44-47, drawn to product described as a "diazaphosphacycle" compound, classified variously in class 564, subclass 16.

III. Claims 25-27, 33-35, 40-42, 48-50, drawn to product described as a "transition metal complex", classified variously in class 585, subclass 275, subclass 277.

IV. Claims 28, 36, 43, drawn to a method of using metal complexes, classified variously in class 585, subclass 277; class 518, subclass 726.

V. Claim 51, drawn to a product described as a "combinatorial library of diazaphosphacycles", classified variously in class 435, subclass 6, DIG 34.

VI. Claim 52, drawn to a product described as a "combinatorial library of transition metal complexes", classified variously in class 435, subclass 6, DIG 30.

VII. Claims 53-54, drawn to a method of "synthesizing a diazaphosphacycle transition metal complex", classified variously in class 558, subclass 321.

VIII Claim 18, drawn to a method for synthesizing a library of diazaphosphacycles, classified variously in class 435, subclass 6, DIG 46.

2. The inventions are distinct, each from the other because of the following reasons:

3. Groups I-VIII represent separate and patentably distinct inventions. Groups I, IV and VII-VIII are drawn to different methods and Groups II-III and V-VI are drawn to different products (i.e., e.g., which are directed to different purposes, use different materials, recite different method or process steps for the preparation of different product(s), screening of different characteristics, such as different binding affinities, different biochemical reaction conditions, etc. or lead to different final results). Therefore, the groups that describe these products and methods have different issues regarding patentability and enablement, and represent patentably distinct subject matter, which merits separate and burdensome searches. Art anticipating or rendering obvious each of the above-identified groups respectively would not necessarily anticipate or render obvious another group, because they are drawn to different inventions that have different distinguishing

4. For example, Groups I, IV and VII-VIII represent separate and patentably distinct methods. The methods are distinct because they use different steps, require different reagents and/or will produce different results. In the instant case, Group VII requires method steps and reagents for "synthesizing a diazaphosphacycle transition metal complex", which are not steps and reagents that are required by the methods of Groups I and IV. Likewise, Group IV requires method steps and reagents for using said metal complexes to catalyze unspecified reaction, which are steps that are not required by the method of Groups I and VII. Likewise, Group VIII requires method steps for producing a library. Therefore, Groups I, IV and VII-VIII have

different issues regarding patentability and enablement and represent patentably distinct subject matter.

5. Furthermore, Groups II-III and V-VI represent patentably distinct products. Groups II-III and V-VI represent separate and patentably distinct products because they differ in respect to their properties, their use and the synthetic methodology for making them. For example, Group V-VI are drawn to a "library", whereas Groups II-III are drawn to a dingle compound. Different reagents and materials are required to produce a library and a library is also used for a different purpose than a single compound. Therefore, Groups II-III and V-VI have different issues regarding patentability and art anticipating or rendering obvious the single compounds would not anticipate or render obvious the library. Likewise, Groups III and VI are drawn to metal complexes that are not required by the products of Groups II and V. Therefore, art anticipating or rendering obvious each of the above-identified groups respectively would not necessarily anticipate or render obvious another group, because they are drawn to different inventions that have different distinguishing features and/or characteristics. Consequently, Groups II-III and V-VI have different issues regarding patentability and enablement and represent patentably distinct subject matter.

6. Furthermore, if applicant were to argue that Groups I and II were somehow related as process of making and product made, the inventions can be shown to be distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different products or (2) that the product as claimed can be made by another and

materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can made by another and materially different process such as solid-phase synthesis or the stepwise condensation of formaldehyde wand phenylphosphane, followed by ring closure with N,N'-dialkylhydrazines.

7. Furthermore, if applicant were to argue that Groups III and VII were somehow related as process of making and product made, the inventions can be shown to be distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different products or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can made by another and materially different process such as solid-phase synthesis.

8. Furthermore, if applicant were to argue that Groups V and VIII were somehow related as process of making and product made, the inventions can be shown to be distinct if either or both of the following can be shown: (1) that the process as claimed can be used to make other and materially different products or (2) that the product as claimed can be made by another and materially different process (MPEP § 806.05(f)). In the instant case, the product as claimed can made by another and materially different process such as solid-phase library synthesis.

9. Finally, if applicant were to argue that any of the Groups III and IV were somehow related as product and process of use, the inventions can be shown to be distinct if either or both of the following can be shown: (1) the process for using the product as claimed can be practiced

with another materially different product or (2) the product as claimed can be used in a materially different process of using that product (MPEP § 806.05(h)). In the instant case, the product(s) as claimed (i.e., Group III) can be used in materially different process of using that product (MPEP § 806.05(h)), for example, the products (i.e., Groups III) could be used as starting materials for creating the library (i.e., Group VI) in addition to being used for catalyzing a reaction (i.e., Group IV).

10. These inventions have acquired a separate status in the art as shown by their different classification and/or divergent subject matter. The different methods and products would require completely different searches in both the patent and non-patent databases, and there is no expectation that the searches would be coextensive. Therefore, this does create an undue search burden, and restriction for examination purposes as indicated is proper.

Species Election

11. This application contains claims directed to patentably distinct species of the claimed invention for Groups I-VIII. Election is required as follows.

12. If applicant elects the invention of Group I, applicant is required to elect from the following patentably distinct species. Claim 1 is generic.

Subgroup 1: Species of diazaphosphacycle (see claim 1)

Applicant must elect for purposes of search a ***single species*** of diazaphosphacycle that is produced by the method of claim 1. Furthermore, applicant must show ***all*** atoms and

bonds that are necessary to define said diazaphosphacycle. Applicant should NOT use general notations like R^1, R^2, etc. when defining the structure because these labels represent more than one chemical group and thus more than one compound would be erroneously elected.

Subgroup 2: Species of phosphine (see claim 1)

Applicant must elect for purposes of search a ***single species*** of phosphine as given by formula I. Furthermore, applicant must show ***all*** atoms and bonds that are necessary to define said phosphine of general formula I. Applicant should NOT use general notations like R^1, R^2, etc. when defining the structure because these labels represent more than one chemical group and thus more than one compound would be erroneously elected.

Subgroup 3: Species of diimine (see claim 1)

Applicant must elect for purposes of search a ***single species*** of diimine. Furthermore, applicant must show ***all*** atoms and bonds that are necessary to define said diimine. Applicant should NOT use general notations like R^1, R^2, etc. when defining the structure because these labels represent more than one chemical group and thus more than one compound would be erroneously elected.

Subgroup 4: Species of optional compound (see claim 1)

Applicant must elect for purposes of search a ***single species*** of optional compound e.g., an acid halide, sulfonyl halide, a phosphoryl halide, or an acid anhydride if present. Furthermore, applicant must show ***all*** atoms and bonds that are necessary to define said optional compound i.e., electing "acid halide", for example, would be insufficient. Applicant should NOT use general notations like R^1, R^2, etc. when defining the structure because these labels represent more than one chemical group and thus more than one compound would be erroneously elected.

Subgroup 5: Species of method steps (see claim 1)

Applicants must elect for purposes of search a single species of method steps that will result in the production of the elected diazaphosphacycle outlining in detail each reagent used to produce said diazaphosphacycle.

13. If applicant elects the invention of Group II, applicant is required to elect from the following patentably distinct species. Claim 24 is generic.

Subgroup 1: Species of diazaphosphacycle (see claim 24)

Applicant must elect for purposes of search a ***single species*** of diazaphosphacycle. Furthermore, applicant must show ***all*** atoms and bonds that are necessary to define said diazaphosphacycle. Applicant should NOT use general notations like R^1, R^2, etc. when defining the structure because these labels represent more than one chemical group and thus more than one compound would be erroneously elected.

14. If applicant elects the invention of Group III, applicant is required to elect from the following patentably distinct species. Claim 25 is generic.

Subgroup 1: Species of diazaphosphacycle metal complex (see claim 25)

Applicant must elect for purposes of search a ***single species*** of diazaphosphacycle metal complex. Furthermore, applicant must show ***all*** atoms and bonds that are necessary to define said diazaphosphacycle. Applicant should NOT use general notations like R^1, R^2, etc. when defining the structure because these labels represent more than one chemical group and thus more than one compound would be erroneously elected. In addition, Applicant must indicate the metal e.g., Rh, Ru, etc. that is bound to the diazaphophacycle and all bond connectivity to the metal.

15. If applicant elects the invention of Group IV, applicant is required to elect from the following patentably distinct species. Claim 28 is generic.

Subgroup 1: Species of diazaphosphacycle metal complex (see claim 28)

Applicant must elect for purposes of search a ***single species*** of diazaphosphacycle metal complex. Furthermore, applicant must show ***all*** atoms and bonds that are necessary to define said diazaphosphacycle. Applicant should NOT use general notations like R^1, R^2, etc. when defining the structure because these labels represent more than one chemical group and thus more than one compound would be erroneously elected. In addition, Applicant must indicate the metal e.g., Rh, Ru, etc. that is bound to the diazaphophacycle and all bond connectivity to the metal.

Subgroup 2: Species of chemical reaction (see claim 28)

Applicant must elect for purposes of search a ***single species*** of chemical reaction that Applicants are catalyzing.

16. If applicant elects the invention of Group V, applicant is required to elect from the following patentably distinct species. Claim 51 is generic.

Subgroup 1: Species of diazaphosphacycle library (see claim 51)

Applicant must elect for purposes of search a ***single species*** of diazaphosphacycle library. The election should result in a ***particularly defined*** core structure that is shared by all library members. In defining this core structure, all variable groups should be defined (i.e. all atoms and bonds shown) as much as possible. However, if no common core structure exists, a representative example of the library must be elected.

17. If applicant elects the invention of Group VI, applicant is required to elect from the following patentably distinct species. Claim 52 is generic.

Subgroup 1: Species of transition metal complex library (see claim 52)

Applicant must elect for purposes of search a ***single species*** of diazaphosphacycle library. The election should result in a ***particularly defined*** core structure that is shared by all library members. In defining this core structure, all variable groups should be defined (i.e. all atoms and bonds shown) as much as possible. However, if no common core structure exists, a representative example of the library must be elected.

18. If applicant elects the invention of Group VII, applicant is required to elect from the following patentably distinct species. Claim 53 is generic.

Subgroup 1: Species of diazaphosphacycle metal complex (see claim 53)

Applicant must elect for purposes of search a ***single species*** of diazaphosphacycle metal complex. Furthermore, applicant must show ***all*** atoms and bonds that are necessary to

define said diazaphosphacycle. Applicant should NOT use general notations like R^1, R^2, etc. when defining the structure because these labels represent more than one chemical group and thus more than one compound would be erroneously elected. In addition, Applicant must indicate the metal e.g., Rh, Ru, etc. that is bound to the diazaphophacycle and all bond connectivity to the metal.

Subgroup 2: Species of method steps (see claim 53)

Applicants must elect for purposes of search a single species of method steps that will result in the production of the elected diazaphosphacycle metal complex outlining in detail each reagent (show structure) used to produce said diazaphosphacycle metal complex.

19. If applicant elects the invention of Group VIII, applicant is required to elect from the following patentably distinct species. Claim 53 is generic.

Subgroup 1: Species of diazaphosphacycle library (see claim 51)

Applicant must elect for purposes of search a ***single species*** of diazaphosphacycle library. The election should result in a ***particularly defined*** core structure that is shared by all library members. In defining this core structure, all variable groups should be defined (i.e. all atoms and bonds shown) as much as possible. However, if no common core structure exists, a representative example of the library must be elected.

Subgroup 2: Species of method steps (see claim 53)

Applicants must elect for purposes of search a single species of method steps that will result in the production of the elected diazaphosphacycle library outlining in detail each reagent (show structure) used to produce said diazaphosphacycle metal complex.

20. **Please Note:** Applicants must disclose which claims read on the elected species (see paragraphs 11 and 12 below).

21. The species are distinct, each from the other, because their structures and modes of action are different. They would also differ in their reactivity and the starting materials from which they are made. For different species of method, the method steps for each species would differ. Moreover, the above species can be separately classified. Consequently, the species have different issues regarding patentability and represent patentably distinct subject matter. Therefore, this does create an undue search burden, and election for examination purposes as indicated is proper.

22. Applicant is required under 35 U.S.C. 121 to elect a single disclosed species for prosecution on the merits to which the claims shall be restricted if no generic claim is finally held to be allowable.

23. Should applicant traverse on the ground that the species are not patentably distinct, applicant should submit evidence or identify such evidence now of record showing the species to be obvious variants or clearly admit on the record that this is the case. In either instance if the examiner finds one of the inventions unpatentable over the prior art, the evidence or admission may be used in a a rejection under 35 U.S.C. 103(a) of the other invention.

24. Applicant is advised that a reply to this requirement ***must include an identification of the species that is elected consonant with this requirement, and a listing of all claims readable thereon, including any claims subsequently added***. An argument that a claim is allowable or that all claims are generic is considered ***nonresponsive*** unless accompanied by an election.

25. Upon the allowance of a generic claim, applicant will be entitled to consideration of claims to additional species which are written in dependent form or otherwise include all the limitations of an allowed generic claim as provided by 37 CFR 1.141. If claims are added after the election, ***applicant must indicate which are readable upon the elected species***. MPEP § 809.02(a).

26. Applicant is advised that the reply to this requirement to be complete must include an election of the invention to be examined even though the requirement be traversed (37 CFR 1.43). Because the above restriction/election requirement is complex, a telephone call to applicants to request an oral election was not made. See MPEP § 812.01.

27. Applicant is reminded that upon cancellation of claims to a non-elected invention, the inventorship must be amended in compliance with 37 CFR 1.48(b) if one or more of the currently named inventors is no longer an inventor of at least one claim remaining in the application. Any amendment of inventorship must be accompanied by a petition under 37 CFR 1.48(b) and by the fee required under 37 CFR 1.17(i).

28. Applicant is also reminded that a 1 – month (not less than 30 days) shortened statutory period will be set for response when a written requirement is made without an action on the merits. This period may be extended under the provisions of 37 CFR 1.136(a). Such action will

not be an "action on the merits" for purposes of the second action final program, see MPEP 809.02(a).

Conclusion

Any inquiry concerning this communication or earlier communications from the examiner should be directed to Jon D Epperson whose telephone number is (703) 308-2423. The examiner can normally be reached Monday through Friday from 8:30 a.m. to 4:30 p.m..

If attempts to reach the examiner by telephone are unsuccessful, the examiner's supervisor, Andrew Wang, can be reached on (703) 306-3217. The fax phone numbers for the organization where this application or proceeding is assigned are (703) 872-9306 for regular communications and (703) 872-9307 for After Final communications.

Any inquiry of a general nature or relating to the status of this application or proceeding should be directed to the receptionist whose telephone number is (703) 308-2439.

Jon D. Epperson, Ph.D.
September 6, 2003

BENNETT CELSA
PRIMARY EXAMINER

REVISED AMENDMENT PRACTICE: 37 CFR 1.121 CHANGED COMPLIANCE IS MANDATORY - Effective Date: July 30, 2003

All amendments filed on or after the effective date noted above must comply with revised 37 CFR 1.121. See Final Rule: **Changes To Implement Electronic Maintenance of Official Patent Application Records** (68 *Fed. Reg.* 38611 (June 30, 2003), posted on the Office's website at: http://www.uspto.gov/web/patents/ifw/ with related information. The amendment practice set forth in revised 37 CFR 1.121, and described below, replaces the voluntary revised amendment format available to applicants since February 2003. **NOTE: STRICT COMPLIANCE WITH THE REVISED 37 CFR 1.121 IS REQUIRED AS OF THE EFFECTIVE DATE (July 30, 2003).** The Office will notify applicants of amendments that are not accepted because they do not comply with revised 37 CFR 1.121 via a Notice of Non-Compliant Amendment. See MPEP 714.03 (Rev. 1, Feb. 2003). The non-compliant section(s) will have to be corrected and the entire corrected section(s) resubmitted within a set period.

Bold underlined italic font has been used below to highlight the major differences between the revised 37 CFR 1.121 and the voluntary revised amendment format that applicants could use since February, 2003.
Note: The amendment practice for **reissues and reexamination proceedings**, except for drawings, has not changed.

REVISED AMENDMENT PRACTICE

I. Begin each section of an amendment document on a separate sheet:
Each section of an amendment document (*e.g.*, Specification Amendments, Claim Amendments, Drawing Amendments, and Remarks) must begin on a separate sheet. Starting each separate section on a new page will facilitate the process of separately indexing and scanning each section of an amendment document for placement in an image file wrapper.

II. Two versions of amended part(s) no longer required:
37 CFR 1.121 has been revised to no longer require two versions (a clean version and a marked up version) of each replacement paragraph or section, or amended claim. Note, however, the requirements for a clean version and a marked up version for substitute specifications under 37 CFR 1.125 have been retained.

A) Amendments to the claims:
Each amendment document that includes a change to an existing claim, cancellation of a claim or submission of a new claim, **must include a complete listing** of all claims in the application. After each claim number in the listing, the status must be indicated in a parenthetical expression, and **the text of each pending claim** (with markings to show current changes) must be presented. The claims in the listing will replace all prior claims in the application.

(1) The current status of all of the claims in the application, including any previously canceled, not entered or withdrawn claims, must be given in a parenthetical expression following the claim number using only one of the following seven status identifiers: (original), (currently amended), (canceled), (withdrawn), (new), *(previously presented) and (not entered).* The text of all pending claims, *including withdrawn claims,* must be submitted each time any claim is amended. Canceled *and not entered* claims must be indicated by only the claim number and status, without presenting the text of the claims.

(2) The text of all claims being currently amended must be presented in the claim listing with markings to indicate the changes that have been made relative to the immediate prior version. The changes in any amended claim must be shown by underlining (for added matter) or strikethrough (for deleted matter) with 2 exceptions: (1) for *deletion of five characters or fewer, double brackets may be used (e.g., [[eroor]]); and (2) if strikethrough cannot be easily perceived (e.g., deletion of the number "4" or certain punctuation marks), double brackets must be used (e.g., [[4]]). As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strikethrough, followed by including and underlining the extra text with the desired change* (e.g., ~~*number 4 as*~~ *number 14 as*). An accompanying clean version is not required and should not be presented. Only claims of the status "currently amended," and "withdrawn" that are being amended, may include markings.

(3) The text of pending claims not being currently amended, *including withdrawn claims,* must be presented in the claim listing in clean version, *i.e.*, without any markings. Any claim text presented in clean version will constitute an assertion that it has not been changed relative to the immediate prior version except to omit markings that may have been present in the immediate prior version of the claims

(4) A claim being canceled must be listed in the claim listing with the status identifier "canceled"; the text of the claim must not be presented. Providing an instruction to cancel is optional.

(5) Any claims added by amendment must be presented in the claim listing with the status identifier "(new)"; the text of the claim must not be underlined.

(6) All of the claims in the claim listing must be presented in ascending numerical order. Consecutive canceled or not entered, claims may be aggregated into one statement (*e.g.*, Claims 1 – 5 (canceled)).

Example of listing of claims (use of the word "claim" before the claim number is optional):

Claims 1-5 (canceled)

Claim 6 (previously presented): A bucket with a handle.

Claim 7 (withdrawn): A handle comprising an elongated wire.

Claim 8 (withdrawn): The handle of claim 7 further comprising a plastic grip.

Claim 9 (currently amended): A bucket with a ~~green~~ blue handle.

Claim 10 (original): The bucket of claim 9 wherein the handle is made of wood.

Claim 11 (canceled)

Claim 12 (not entered)

Claim 13 (new): A bucket with plastic sides and bottom.

B) Amendments to the specification:

Amendments to the specification, including the abstract, must be made by presenting a replacement paragraph or section or abstract marked up to show changes made relative to the immediate prior version. An accompanying clean version is not required and should not be presented. Newly added paragraphs or sections, including a new abstract (instead of a replacement abstract), must not be underlined. A replacement or new abstract must be submitted on a separate sheet, 37 CFR 1.72. If a substitute specification is being submitted to incorporate extensive amendments, both a clean version (which will be entered) and a marked up version must be submitted as per 37 CFR 1.125.

The changes in any replacement paragraph or section, or substitute specification must be shown by underlining (for added matter) or strikethrough (for deleted matter) with 2 exceptions: (1) for *deletion of five characters or fewer, double brackets may be used (e.g., [[eroor]]); and (2) if strikethrough cannot be easily perceived (e.g., deletion of the number "4" or certain punctuation marks), double brackets must be used (e.g., [[4]]). As an alternative to using double brackets, however, extra portions of text may be included before and after text being deleted, all in strikethrough, followed by including and underlining the extra text with the desired change* (*e.g.*, ~~*number 1 as*~~ *number 14 as)*

C) Amendments to drawing figures:

Drawing changes must be made by presenting replacement figures which incorporate the desired changes and which comply with 37 CFR 1.84. An explanation of the changes made must be presented either in the drawing amendments, or remarks, section of the amendment, *and may be accompanied by a marked-up copy of one or more of the figures being amended, with annotations.* Any replacement drawing sheet must *be identified in the top margin as "Replacement Sheet"* and include all of the figures appearing on the immediate prior version of the sheet, even though only one figure may be amended. *Any marked-up (annotated) copy showing changes must be labeled "Annotated Marked-up Drawings" and accompany the replacement sheet in the amendment (e.g., as an appendix).* The figure or figure number of the amended drawing(s) must **not** be labeled as "amended." If the changes to the drawing figure(s) are not accepted by the examiner, applicant will be notified of any required corrective action in the next Office action. No further drawing submission will be required, unless applicant is notified.

Questions regarding the submission of amendments pursuant to the revised practice set forth in this flyer should be directed to: Elizabeth Dougherty or Gena Jones, Legal Advisors, or Joe Narcavage, Senior Special Projects Examiner, Office of Patent Legal Administration, by e-mail to patentpractice@uspto.gov or by phone at (703) 305-1616.